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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,294	10/14/2003	Matt G. Driggers	10004246-2	7111
7590	08/18/2005			EXAMINER COLILLA, DANIEL JAMES
			ART UNIT 2854	PAPER NUMBER

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/686,294	DRIGGERS, MATT G. 
	Examiner	Art Unit
	Daniel J. Colilla	2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 October 2003.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12,14-16 and 18-25 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-12,14-16 and 18-25 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 14 October 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/14/03</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 11 and 15 are objected to because of the following informalities:

In claim 11, line 2, it appears that "slack" should actually be --stack.--

In claim 15, lines 4-5, "said print job" has no proper antecedent basis in the claims.

Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,688,740. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of recites all that is recited in claim 1 of the present application except for the term "selectively." However, the stack accessory (media stack receptacle) inherently can be selectively attached to the printer due to the mounting structure attachable at the mounting site of the printer.

4. Claim 14 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,688,740. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of recites all that is recited in claim 14.

5. Claim 20 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,688,740. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of recites all that is recited in claim 1 of the present application except for the printer selectively attached thereto. However, claim 1 of U.S. Patent No. 6,688,740 recites that the infeed module is for use with a printer and it inherently can be selectively attached to the printer due to the mounting structure attachable at the mounting site of the printer.

Claim Rejections - 35 USC § 102

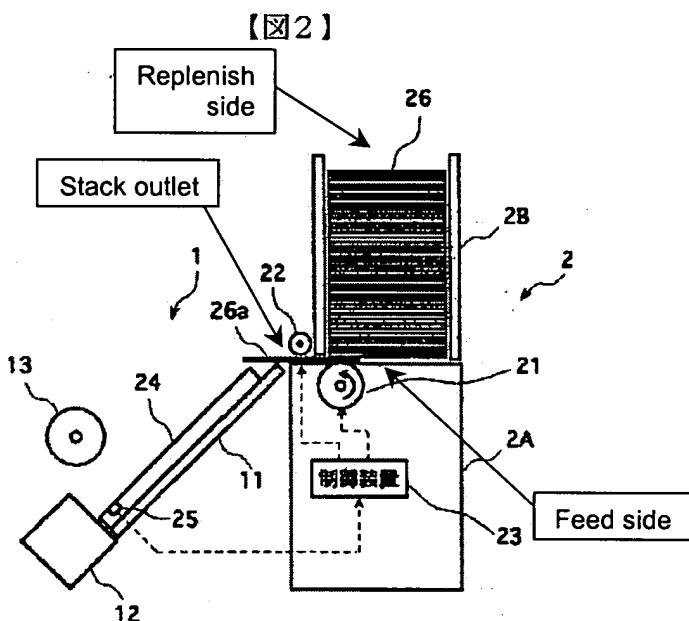
6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-2, 9-11 and 20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Okada (JP 2001-58728).

With respect to claims 1 and 20, Okada discloses an infeed module (or stack accessory) used with a printer including a mounting structure (not shown, see paragraph [0008], lines 1-2 of the machine translation of Okada) that is selectively attachable at a mounting site of a printer, a media stack receptacle 2B with a feed side and a replenish side and a stack outlet adjacent the feed side as shown in the Figure below taken from Figure 2 of Okada:



With respect to claim 2, the outlet includes a feed wheel 21.

With respect to claim 9, the replenish side of the stack receptacle is on the upper side as shown in Figure 2 of Okada.

With respect to claim 10, the feed side of the stack receptacle is on the bottom side as shown in Figure 2 of Okada.

With respect to claim 11, the replenish side of the stack receptacle is on the upper side, and the feed side of the stack receptacle is on the bottom side as shown in Figure 2 of Okada.

With respect to claim 21, the stack accessory defines a media feed path at least past roller 22 and down onto tray adapter 24 as shown in Figure 2 of Okada.

With respect to claim 22, the feed path includes a first portion defined by the bottom of the stack accessory at least past the roller 22 and a second portion defined by the printer which includes tray adapter 24.

With respect to claim 23, the printing device is capable of receiving additional media without interrupting a printing operation by adding more printing media to the media replenishing opening.

With respect to claim 24, the media stack is removably mountable to the printer (not shown, see paragraph [0008], lines 1-2 of the machine translation of Okada).

With respect to claim 25, the stack accessory propels media therefrom a fixed distance; the distance from the outlet to the stop 12 as shown in Figure 2 of Okada.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (JP 2001-58728), as applied to claims 1-2, 9-11 and 20-25 above, and further in view of Miyazaki (JP 10-297773).

With respect to claim 3, Okada discloses the claimed infeed module except for the semi-annular surface portion and second surface portion of the feed wheel. However, Miyazaki teaches a infeed device with a feed wheel 20 with a semi-annular portion 20a and a second portion 20b as shown in Figures 1-2 of Miyazaki. It would have been obvious to combine the teaching of Miyazaki with the infeed module disclosed by Okada for ensuring appropriate feed of the printing paper without requiring complicated structure and for reducing back tension in the printing paper.

With respect to claim 4, the circumferential dimension of the semi-annular surface portion has the capability to correspond to a given length portion of a media feed path portion beginning at the outlet side of the stack receptacle and extending into a printer.

With respect to claim 5, the feed path that begins at the outlet of the stack receptacle (at the location or roller 22)can be considered to terminate at feed device 13 as shown in Figure 2 of Okada.

With respect to claim 6, Okada discloses the claimed infeed module except for the reciprocating arm. However, Miyazaki teaches a reciprocating arm 21 of which the feed roller 20 is mounted at a distal end. The arm 21 reciprocates, as shown in Figures1-2 of Miyazaki, for coordinated contact with the media S so that the feed wheel 20 propels media S out of the stack outlet. It would have been obvious to combine the teaching of Miyazaki with the infeed module disclosed by Okada for ensuring appropriate feed of the printing paper without requiring complicated structure and for reducing back tension in the printing paper.

With respect to claim 7, the feed wheel 21 disclosed by Okada propels the media 26a along a feed path portion onto tray adapter 24.

With respect to claim 8, the feed path portion terminates at feed device 13. The feed device 13 continues to feed the media along an overall path as shown in Figure 3(

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada (JP 2001-58728), as applied to claims 1-2, 9-11 and 20-25 above, and further in view of Konishi et al. (4,982,942).

Okada discloses the claimed infeed module except for the high friction surface. However, Konishi et al. teaches an infeed module with a feed wheel 2 with high friction surface 10-1. The movement of the high friction surface 10-1, being located on the feed wheel 2 is driven mechanically as is inherent in feed wheels. It would have been obvious to combine the teaching of Konishi et al. with the infeed module disclosed by Okada for the advantage of a surer grip on the print media by the feed wheel to prevent slippage.

11. Claims 14, 15, 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stemmle (US 5,875,383) in view of Ettischer et al. (US 4,696,615).

With respect to claim 14, Stemmle discloses the claimed method of printer operation except for the stack accessory having an open replenish side. Stemmle discloses a printer 10 in combination with a stack accessory 30 that is selectively attached to the printer 10 as shown in Figures 1 and 2 of Stemmle. The stack accessory passes a sequence of media from a stack receptacle 24 into a feed mechanism of the printer 10 as shown below in the Figure taken from Figure 2 of Stemmle:

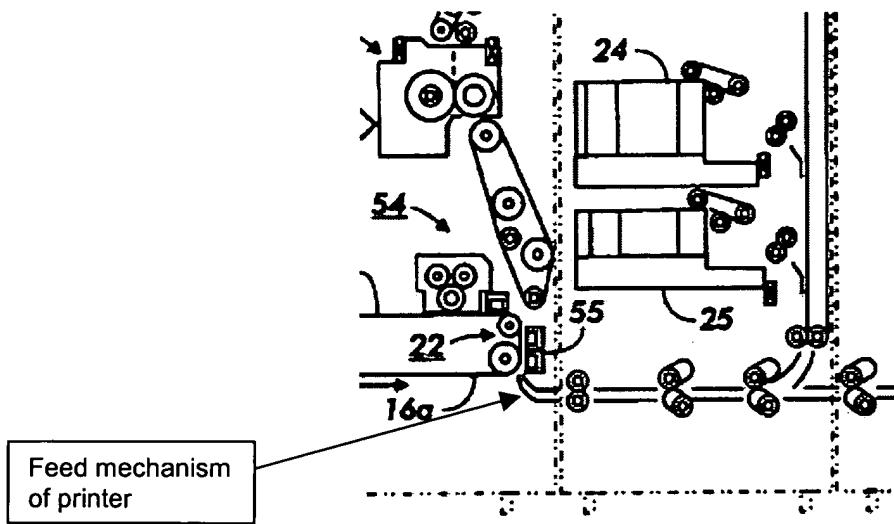


FIG. 2

Stemmle further discloses a media transport mechanism as shown below in the Figure taken from Figure 1 of Stemmle:

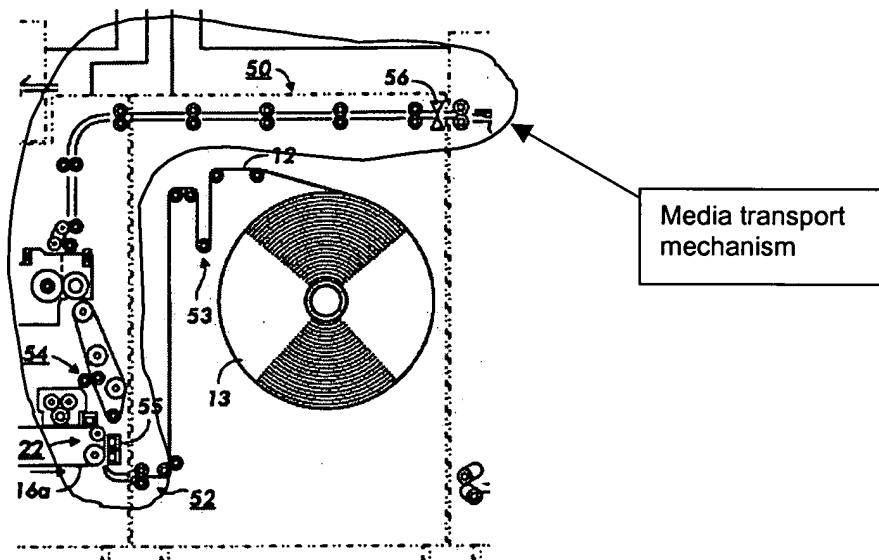
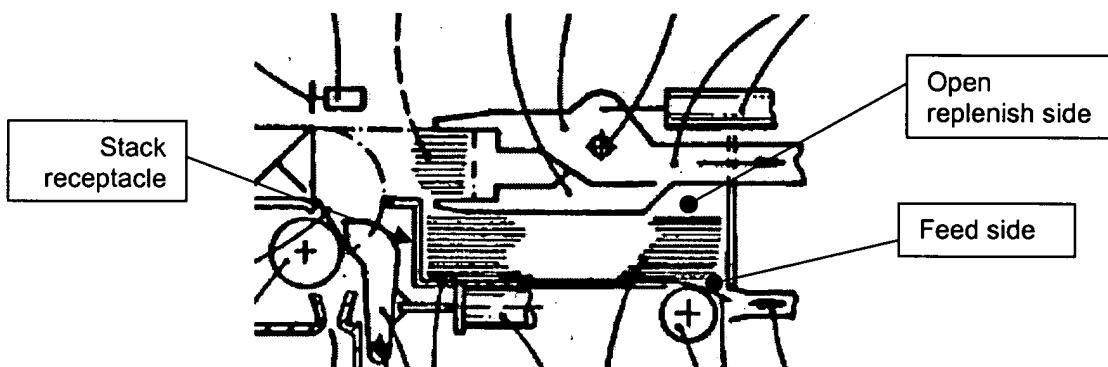


FIG. 1

the step of removing a first portion of the media transport mechanism (the portion in section 50--section 50 being removed) and replacing it with a stack accessory 30 as shown in Figure 2 of Stemmle. The stack accessory complements the second portion of the media transport mechanism (the portion in the printer 10) in the sense that it completes the media transport mechanism.

It is not known to the examiner if the stack receptacle 24 has an open replenish side. However, Ettischer et al. discloses a printer including a stack receptacle 7 with an open replenish side and a feed side opposite the replenish side as shown below in the Figure taken from Figure 1 of Ettischer et al.:



It would have been obvious to combine the teaching of Ettischer et al. with the method of printing disclosed by Stemmle for the advantage of automatically opening paper packages and refilling the stack receptacle without interrupting the printing process (see abstract of Ettischer et al.).

With respect to claim 15, in order to be functional, the printer inherently is instructed to print, otherwise a printing process would not be completed. The abstract of Ettischer et al. teaches replenishing the stack accessory as necessary.

With respect to claim 16, the above Figure from Ettischer et al. shows the step of replenishing the stack receptacle at its replenish side.

With respect to claim 18, Stemmle discloses imaging station 22 for applying print imaging to the media.

With respect to claim 19, Stemmle discloses identifying the accessory in use (30 or 50) by reprogramming the controller 100. (Stemmle, col. 9, lines 16-24)

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nakayama is cited to show another example of an infeed module that can be mounted to a printer.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 10, 2005



Daniel J. Colilla
Primary Examiner
Art Unit 2854